

REMARKS

The Applicant notes with appreciation the Examiner's thorough review of the present application as evidenced by the Office Action. In response, the Applicant has amended the claims to more clearly recite the invention. The Applicant has also provided remarks below, in response to the rejections in the Office Action. In light of the amendments above and the remarks that follow, the Applicant respectfully submits that all the claims of the application are patentable.

REISSUE DECLARATION

The Examiner asserts the reissue declaration is defective because it fails to identify the foreign applications to which priority is claimed. Also, the Examiner rejected all the pending claims on the grounds that the claims are based upon a defective reissue declaration.

The Applicant has prepared a Supplemental Reissue Declaration that will be signed by the inventors and filed before this reissue application issues.

WITHDRAWAL OF CLAIM REJECTION – 35 U.S.C. § 103

The Applicant notes the Examiner has withdrawn the prior art rejection under 35 U.S.C. § 103(a) based upon U.S. Patent No. 3,857,660 to *Flynn et al.*, alone or in combination with other patents. For the record, however, the Applicant disagrees with the Examiner's characterization of the teaching of *Flynn* and the Examiner's description of the rationale and function of the positioning assemblies.

CLAIM 27

The Examiner requested clarification of a statement made on page 8 of the Remarks section in the Applicant's last response concerning the cancellation of independent claim 27. The inclusion of the sentence, "Independent claim 27 has been canceled" was a typographical error. The Applicant did not cancel or intend to cancel claim 27.

NEW CLAIMS 32-44

In accordance with 37 C.F.R. § 1.173(c), the Applicant explains that support exists in the disclosure for all the added claims.

Claims 32-37 recite a mold shell comprising a shell body (shell 7) and a mold bottom (mold bottom 25) as shown in Figure 2 and disclosed in the specification at Column 4, line 47, to Column 5, line 29.

Claims 38-44 recite a shell body (shell 7) as shown in the drawing and disclosed in the specification at Column 4, line 21, to Column 5, line 29.

CLAIM REJECTIONS – RECAPTURE

I. THE REISSUE CLAIMS DO NOT RECAPTURE SURRENDERED SUBJECT MATTER BECAUSE THE MOLD CARRIER SHAPE CONTINUES TO BE A REQUIRED CHARACTERISTIC OF THE CLAIMED ARTICLE.

The recapture rule does not bar the reissue claims because the narrowing amendment (the mold carrier shape) continues to be a required characteristic of the article in the reissue claims. The recapture rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.” *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 2003 WL 21542454, at *11 (BD. PAT. APP. & INTERF. May 29, 2003), *quoting In re Clement*, 131 F. 3d 1464, 1468 (Fed. Cir. 1997). Analysis of the pending reissue claims using the *Clement* test confirms there is no recapture. The reissue claims are narrower because the mold carrier shape continues to be required, and broader because the claims recite an article of manufacture that corresponds to the machine claims in the patent.

The *Clement* recapture test includes two steps. First, whether the reissue claims are broader than the surrendered subject matter and in what respect. Second, whether those broader aspects of the reissue claims relate to the surrendered subject matter. The second step requires analysis of the subject matter surrendered and whether the broadening aspect relates to the surrendered subject matter. The court in *Clement* stated the following principles:

- (1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim;
- (2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible;
- (3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then:
 - (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

Eggert at *13, *quoting Clement* at 1469-70. Applying the *Clement* test here, the pending reissue claims are an example of principle (3)(b) and the recapture rule therefore does not bar the claims.

A. The Reissue Claims Are Narrower Than the Surrendered Subject Matter, In an Aspect Germane to the Rejection.

The reissue claims are narrower because the mold carrier shape continues to be a required characteristic. Under the principles enumerated in *Clement*, category (3)(b) applies, “if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection” and the recapture rule does not bar the claim. *Eggert* at *13, *quoting Clement* at 1469-70. Because the mold carrier shape continues to be a required characteristic, the reissue claims are narrower than the surrendered subject matter.

The subject matter surrendered during prosecution of the machine claim was: a device without the enveloping characteristic of the mold carriers. Claim 1 was amended to add the phrase, “which are made in the form of enveloping structures.” The original claim 1 and the amendment made during prosecution are shown below:

Original Independent Claim 1 of the '089
Application Read as Follows:

Device for manufacturing containers, in particular bottles, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform,

the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Independent Claim 1 after the only
Amendment in the '089 Application and Issued
as Claim 1 of the '560 Patent (deletions in
strikeout; additions in bold):

Device for manufacturing containers, in ~~particular bottles~~, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform,

the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) **which are made in the form of enveloping structures** and which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

In traversing the obviousness rejection, the Applicant argued, “neither *Appel* nor *Schavoir* teach or suggest . . . an enveloping mold carrier” (Amendment at 7). The amendment and traversal of the prior art rejection represents a surrender of a device that does not include the enveloping characteristic of the mold carriers.

The Examiner argues the reissue claims constitute recapture because the mold carrier shape is recited as a characteristic of the shell holders instead of as a separate structural element. Referring to Claim 1 in the table above, however, shows that the claim amendment includes only the mold carrier shape: “made in the form of enveloping structures.” The two mold carriers were already present in the claim.

In support of the recapture position, the Examiner has cited *Pannu v. Storz Instruments*, 258 F.3d 1366 (Fed. Cir. 2001). In *Pannu*, the Applicant limited the shape of the claimed haptics by adding the new phrase “continuous, substantially circular arc” to claim 16. *Pannu* at 1371. The reissue claims eliminated the new phrase and instead claimed haptics having a length “substantially greater . . . [to] at least three times greater” than the width. *Id.* at 1372.

The Examiner’s argument that the “two mold carriers” were the surrendered subject matter is not supported by *Pannu* because the haptics in *Pannu* were not surrendered in order to overcome the prior art rejection. Instead, the surrendered subject matter was: any haptics not having the characteristic new shape of a “continuous, substantially circular arc.” The haptics element itself was not the surrendered subject matter in *Pannu*. Only the shape was limited. The haptics were already present in the claim. Thus, the facts of *Pannu* do not support the Examiner’s argument that the “two mold carriers” were surrendered in this case. The two mold carriers were present before and after the amendment.

The reissue claims are narrower than the surrendered subject matter because “shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures” adds the same limitation on the mold carrier shape, now as a characteristic of the shell holders. Below is a comparison of patent claim 1 and reissue claim 15. (Reissue claims 15, 35, 36, and 39 all include the same mold carrier shape limitation).

Issued Claim 1 of the '560 Patent
(amendments shown; deletions in strikeout;
additions in bold):

Device for manufacturing containers, ~~in particular bottles,~~ made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including

at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) **which are made in the form of enveloping structures and** which can move one with respect to the other,

characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and

a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being of complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Because the characteristic shape is still required, the reissue claims are narrower than the rejected claim in an aspect germane to the prior art rejection.

The distinguishing characteristic of "mold carriers made in the form of enveloping structures" is present in both the patent claim and the reissue claims. The mold carrier shape continues to be required in the reissue claims. The Applicant did not surrender the option of

New Claim 15 of the Reissue Application,
after Amendment, compared to Issued Claim 1
(addition in bold):

A mold assembly for use in manufacturing molded thermoplastic containers comprising:

two mold shells each containing a half-impression of a substantial portion of the container to be molded;

two mold shell holders each defining a cavity for receiving each said respective mold shell such that each said respective mold shell is in at least partial mutual thermal-conduction contact with its respective shell holder, **said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures** movable one with respect to the other; and

at least one quick-fixing locking member by which at least one of said mold shells is removably secured to a respective one of said mold shell holders, said one quick-fixing locking member including a selectively retractable locking member portion.

claiming the same invention as an article of manufacture instead of a machine. Because the distinguishing characteristic continues to be required in the reissue claims, and because the mold carrier shape represents the same limitation that was added when the patent claim was amended, the reissue claims are narrower than the surrendered subject matter, in an aspect germane to the prior art rejection.

B. The Reissue Claims Are Broader Than the Surrendered Subject Matter, In an Aspect Unrelated to the Rejection.

The reissue claims are broader because they recite an article of manufacture corresponding to the machine claimed in the issued patent. Under the *Clement* recapture test, the first question is whether the reissue claims are broader than the surrendered subject matter and in what respect. *Clement* at 1468. Claiming an invention in a different statutory category is a broadening reissue, *see* MPEP § 1412.02, but in the present case, the shift in statutory category is unrelated to the prior art rejection made during prosecution.

The reissue claims recite the same patentable subject matter as the patent claim, but in a different statutory category. The patent claim recites a “device for manufacturing containers,” which is a machine under 35 U.S.C. § 101.¹ The reissue claims recite a “mold assembly,” which is a manufacture (or article of manufacture) under Section 101.²

A patentee may file a reissue application to permit consideration of claims written in a different statutory category where the reissue claims correspond to the patented claims. MPEP § 1412.02. The following paragraph of Section 1412.02 explains that the consideration of claims, presented in a different category, is proper in a reissue application:

¹ “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101.

² The Examiner argues that the mold assembly is not a separate statutory category, but is a subcombination in relation to the manufacturing device of Claim 1. The Applicant disagrees. The Examiner has cited no support for a conclusion that a subcombination cannot be a separate statutory category. A computer-readable medium containing software, such as a hard drive, is a good example of

MPEP § 1412.02. Reissue for Article Claims Which Are Functional Descriptive Material Stored on a Computer-Readable Medium.

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the “article” claims) must have been made as a result of error without deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

MPEP § 1412.02 (emphasis in original). This paragraph of Section 1412.02 addresses the “statutory category change” situation in terms of seeking article claims (for the code on a drive) that correspond to the patented machine or process claims (for the software process). Similarly, here, the reissue claims being sought are article claims (for the mold assembly) that correspond to the patented machine claims (for the manufacturing device).

In the example described in Section 1412.02, the patented claims for a software process may include several steps, positively recited. For example, a software process claim may include, “storing said value in a database.” The article claims for the “functional descriptive material stored on a computer-readable medium” being sought in reissue may include, “said computer-readable medium configured to store said value in a database.” The step of storing is not positively recited in the article claims. Nevertheless, the medium must be configured to carry out the storing step. The article claims may be properly sought in a reissue application if the error was made without deceptive intent.

an article of manufacturer that might be considered a subcombination of a computing machine. *Compare* MPEP § 1412.02, discussed below.

Applying Section 1412.02 to the present case, the patented machine claim for a “device for manufacturing containers” includes several elements, positively recited:

“at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures”

(U.S. Patent No. 5,968,560, Claim 1). The article claims for the “mold assembly” being sought in reissue include:

“two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures”

(Reissue Application, Claim 15). Like the step of storing in the software example, the two mold carriers are not positively recited in the article claims. Nevertheless, the mold assembly must include shell holders configured to be supported by two mold carriers having an enveloping shape.

The shift in statutory category is unrelated to the prior art rejection made during prosecution for several reasons. First, the Applicant did not surrender the option of seeking corresponding article claims. The article claims may be properly sought in this reissue application because the error of not pursuing claims to the mold assembly article along was made without deceptive intent. The Reissue Declaration expressly cites the lack of article claims such as “to the mold shells standing alone” as an error sought to be corrected through reissue.

Second, the presentation of article claims cannot be germane to the prior art rejection because the Examiner admitted the article claims are patentable over the prior art. The Applicant and the Examiner agree that all the article claims are patentably distinguishable and allowable over the prior art.

The reissue claims are broader because they claim the invention in a different statutory category. The shift in statutory category is unrelated to the prior art rejection because the option of seeking corresponding article claims was not surrendered.

CONCLUSION

After entry of the requested amendment, claims 21-44 are pending in the application. Support for each new claim may be found in the specification. In light of the amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

The Applicant also submits herewith a Request for Continued Examination (RCE), along with the required fee.

The Applicant also submits herewith a Petition and Fee for Extension of Time, along with the required fee.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination.

The Applicant does not believe any fees for extensions of time or net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any required fees (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account Number 16-0605.

Respectfully submitted,


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The recapture rule, therefore, does not bar the claim. Under the *Clement* test and *Ex parte Eggert*, if the reissue claims are broader than the surrendered subject matter in some aspects and narrower than the surrendered subject matter in other respects, and if the reissue claim is narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. *Eggert* at *13; *Clement* at 1469-70. Applying this test to the pending reissue claims:

- The reissue claims are narrower than the patent claim prior to amendment (*i.e.*, narrower than the surrendered subject matter) in that the same enveloping characteristic of the mold carrier continues to be required in the reissue claims.
- The reissue claims are broader than the surrendered subject matter because the reissue claims are directed to an article of manufacture instead of a machine. *See* MPEP § 1412.02.
- The narrowing aspect (continuing to require the enveloping characteristic of the mold carriers) is germane to the rejection because the shape was limited by amendment and remains a required limitation in the reissue claims.
- The broadening aspect (claiming the article corresponding to the machine) is not germane to the rejection, because a change in statutory category is germane to the rejection, and the article claim is patentable over the prior art as determined by the Examiner in the reissue.

Accordingly, under *Clement* and *Ex parte Eggert*, the requirements of paragraph 3(b) of *Clement* test are satisfied and the recapture rule does not bar the reissue claims.